

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	Customer Number: 46320
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Allen GILBERT, et al.	:	Confirmation Number: 1393
	:	
Application No.: 10/635,586	:	Group Art Unit: 2142
	:	
Filed: August 6, 2003	:	Examiner: C. Biagini
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Appeal No. 2009-006032	:	
	:	
For: ONLINE AUTONOMIC OPERATIONS GUIDE	:	

REQUEST FOR REHEARING

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Request for Rehearing is submitted under 37 C.F.R. § 41.52 in response to the Decision on Appeal dated June 9, 2010 (hereinafter the Decision). This Request for Rehearing is timely filed within the two month time period for reply set forth under 37 C.F.R. § 41.52(a)(1).

Appellants respectfully submit that in the Decision, the Honorable Board either misapprehended and/or overlooked certain arguments presented by Appellants in the Appeal Brief of February 22, 2008, and in the Reply Brief of June 17, 2008. Appellants will specifically identify these particular points below.

REMARKS

Decisions of the PTO tribunals are reviewed in accordance with the standards of the Administrative Procedure Act. See Dickinson v. Zurko, 527 U.S. 150, 165 (1999) (applying the Administrative Procedure Act, 5 U.S.C. § 706, to appeals of PTO rulings). Thus, the Board's factual findings are reviewed to determine whether they are unsupported by substantial evidence, and the Board's legal conclusions are reviewed for correctness in law. See In re Gartside, 203 F.3d 1305, 1312 (Fed. Cir. 2000). Substantial evidence means "more than a mere scintilla. It means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion." Richardson v. Perales, 402 U.S. 389, 401 (1971).

"responsive to a request to perform an administrative task directed to a resource within a computing network"

The above-identified limitations are found in claim 1. Referring to page 3 of the Examiner's Answer, the Examiner relied solely upon Lortz to teach these limitations. However, Appellants' position, as presented in the Appeal Brief and the Reply Brief, is that Lortz fails to teach all of these limitations for which the Examiner is relying upon Lortz to teach.

Referring to page 6, lines 14-18 of the Appeal Brief, Appellants first noted that the Examiner failed to provide a claim construction for the claimed "a request to perform an administrative task." Referring to page 6, line 20 through page 7, line 16 of the Appeal Brief, Appellants then proceeded to explain why the teachings relied upon by the Examiner do not teach the claimed "a request to perform an administrative task." Referring to page 2, line 12 through page 4, line 8 of the Reply Brief, Appellants further addressed these limitations.

Specifically, Appellants again noted that the Examiner failed to provide a claim construction for the term "administrative task" despite this term being at the center of the disagreement between Appellants and the Examiner. Appellants, after again explaining why "a resource request from a client device 12" does not teach "a request to perform an administrative task" concluded by noting that the Examiner's analysis was unsupported by substantial evidence.

Turning to the first full paragraph on page 9 of the Decision, the Honorable Board begins by noting the following:

Appellants further contend that no explanation is given why claim construction of "request to perform an administrative task," as claimed, is a reasonable construction (App. Br. 6, middle). In the Patent Office, claims are given their broadest reasonable construction when read in light of the Specification. (*See In re Zletz*, cited above.)

Appellants have no issue with the above statement except to note that 37 C.F.R. § 1.104(b) states that "[t]he examiner's action will be complete as to all matters." In addition, 37 C.F.R. § 1.2 states "[t]he action of the Patent and Trademark Office will be based exclusively on the written record in the Office." Thus, if the Examiner did give the claims "their broadest reasonable construction when read in light of the Specification," the Examiner did not share this claim construction with Appellants in the written record. As stated by Appellants on page 3, lines 6-8 of the Reply Brief:

By not explicitly setting forth a claim construction, the Examiner has prevented Appellants from having the opportunity to evaluate the rationale and evidence supporting the Examiner's rationale for the Examiner's unstated claim construction.

Returning again to the first full paragraph on page 9 of the Decision, the Honorable Board further notes the following:

In this case, we note that Appellants' Specification merely discloses examples of the claimed "administrative task." (See ¶ [0029].) Upon reviewing the Specification, we find that Appellants chose not to specifically limit the meaning of an administrative task by definitively stating what an "administrative task" does and does not include (*id.*).

The Honorable Board is correct in asserting that Appellants did not specifically limit the meaning of an administrative task. However, the Honorable Board cannot ignore that Appellants' Specification is intrinsic evidence as to the meaning of the phrase "administrative task."

In the last portion of the first full paragraph on page 9 of the Decision, the Honorable Board concludes the following:

Accordingly, we broadly but reasonably, *see Zletz*, cited above, read Appellants' claimed "request to perform an administrative task" as being a request to access a resource on a network, as disclosed in the Lortz reference. (*See* FF#2.) Accordingly, we find no error in the Examiner's rejection.

Appellants respectfully submit that in concluding what the Examiner just did (i.e., "we ... read Appellants' claimed 'request to perform an administrative task' as being a request to access a resource on a network"), the Honorable Board has failed to address the issue identified by Appellants in the first line of this paragraph which is "Appellants further contend that no explanation is given why claim construction of 'request to perform an administrative task,' as claimed, is a reasonable construction."

1
2 The Honorable Board's conclusion includes no analysis. The Honorable Board does not
3 refer to a claim construction of the terms of the claim language at issue. The Honorable Board
4 does not cite to any evidence regarding the ordinary and customary usage of the terms of the
5 claim language at issue, as those terms would be understood by one of ordinary skill in the art.
6 The Honorable Board does not cite to any evidence regarding the plain meaning of the terms of
7 the claim language at issue.

8
9 The reason why the Honorable Board could not rely upon any of these findings is that the
10 Examiner's failed to produce both analysis and findings of fact, supported by substantial
11 evidence, in support of Examiner's conclusion that a request to access a resource on a network, as
12 taught by Lortz, corresponds to the claimed "a request to perform an administrative task."

13
14 On February 26, 2010, the precedential opinion of Ex parte Frye, Appeal 2009-006013,
15 was issued by the Board of Patent Appeals and Interferences (BPAI). Referring to the first full
16 paragraph on page 15 of Ex parte Frye, the following was stated:

17 Our decision is limited to the finding before us for review. The Board does
18 not "allow" claims of an application and cannot direct an examiner to pass an
19 application to issuance. Rather, the Board's primary role is to review adverse
20 decisions of examiners including the findings and conclusions made by the
21 examiner. See 37 C.F.R. § 41.50(a)(1) ("The Board, in its decision, may affirm or
22 reverse the decision of the examiner in whole or in part on the grounds and on the
23 claims specified by the examiner").[footnote 2 omitted] (underline added)

As discussed in the above-reproduced passage, a decision of the BPAI is limited to the findings and conclusions made by the Examiner. However, since the Examiner made no findings, supported by substantial evidence, to support the Examiner's implied claim construction, the Honorable Board could not cite to any evidence in the Decision. Instead, the Honorable Board concluded, without evidence, that "we ... read Appellants' claimed 'request to perform an administrative task' as being a request to access a resource on a network," Appellants' position is that the Honorable Board cannot agree with a factual finding, by the Examiner, that the applied prior art teaches certain limitations when there is no substantial evidence to support such a factual finding.

Referring to the paragraph spanning pages 9 and 10 of the Decision, with regard to these same limitations at issue, the Honorable Board further asserted:

We find Appellants' logic unpersuasive because the argument is not commensurate with the scope of claim 1. We note that exemplary claim 1 does not recite specific persons or groups of people who are permitted to perform the claimed "administrative task." Rather, the claim merely recites, in relevant part, "a systems administration policy enforcement method comprising" the claimed "retrieving" and "permitting" steps. Since the claim does not specify the actor who performs the "administrative task," Appellants' argument falls outside the scope of the claim language. We thus find unpersuasive Appellants' argument. Accordingly, we find no error.

Appellants respectfully submit that the Honorable Board has overlooked that Appellants' arguments are directed to intrinsic evidence as to meaning of the term "administrative task." As noted by the Federal Circuit in Phillips v. AWH Corp., 415 F.3d 1303 (Fed. Cir. 2005) (en banc), "[q]uite apart from the written description and the prosecution history, the claims themselves

provide substantial guidance as to the meaning of particular claim terms." Therefore, when comparing the term "administrative" to "an administrator," Appellants are merely relying upon intrinsic evidence to provide a clue as to a proper claim construction of the limitations at issue.

Referring again to Ex parte Frye, the following was stated in the paragraph spanning pages 9 and 10:

The panel then reviews the obviousness rejection for error based upon the issues identified by appellant, and in light of the arguments and evidence produced thereon. *See Oetiker*, 977 F.2d at 1445 ("In reviewing the examiner's decision on appeal, the Board must necessarily weigh all of the evidence and argument." (emphasis added); *see also* 37 C.F.R. § 41.37(c)(1)(vii) (appeal brief must include "the contentions of appellant with respect to each ground of rejection presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on"). Specifically, the Board reviews the particular finding(s) contested by an appellant anew in light of all the evidence and argument on that issue. (emphasis in original).

As stated therein the Honorable Board is to weigh all of the evidence and argument. The Examiner has presented no claim construction for the term "an administrative task." Moreover, the Examiner, however, has produced no evidence, intrinsic or extrinsic, as to the meaning of the term "an administrative task." On the contrary, Appellants have produced intrinsic evidence to support a claim construction that does not permit one to "read Appellants' claimed 'request to perform an administrative task' as being a request to access a resource on a network." Thus, when the evidence is weighed, the Honorable Board cannot agree with the Examiner that Lortz teaches the claimed "responsive to a request to perform an administrative task directed to a resource within a computing network."

New Ground of Rejection

If the Honorable Board believes that the present rejection should be maintained, designation as a new ground is necessary because Appellants have not had a fair opportunity to react to the thrust of the "affirmance" of the rejection, which is based upon a characterization of the prior art that was not relied on by the Examiner. See In re Kumar, 418 F.3d 1361, 1367-68 (Fed. Cir. 2005) ("the ultimate criterion of whether a rejection is considered 'new' in a decision by the board is whether appellants have had fair opportunity to react to the thrust of the rejection") (quoting In re Kronig, 539 F.2d 1300, 1302 (CCPA 1976)). Denial of an opportunity to respond to a new rejection represents a deprivation of the Appellants' administrative due process rights. In re Kronig 539 F.2d at 1303, 190 USPQ at 426.

As both a matter of practicality and fairness, Appellants cannot establish error in the Examiner's analysis where the Examiner's analysis is not being used in rejecting the claims. Appellants reasonably cannot (and should not) be required to comb through each and every cited reference and explain, line by line, how every possible teaching within the applied prior art does not teach the limitations at issue. To do so would require the filing of Appeal Briefs hundreds of pages long.

Appellants recognize that a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. However, the Examiner is still required to establish a prima facie of anticipation or obviousness, which includes specifically identifying those elements, in the applied prior art, that allegedly identically disclose the claimed limitations. See 37 C.F.R. § 1.104(c). To require Appellants to respond to findings and/or

conclusions not made by the Examiner would improperly shift the initial burden of proof from the Examiner to Appellants.

Referring to the last full paragraph on page 10 of the Decision, the Honorable Board asserted the following:

We concentrate on Lortz for all of the limitations of claim 1. We regard the Hopmann reference as cumulative prior art, in that it discloses accessing a resource on a computer system on the basis of whether a file is locked (*i.e.*, in use by a computer user) or unlocked (*i.e.*, not in use by a computer user) (FF#3). (emphasis added)

Referring to the underlined portion of the above-reproduced passage, the Honorable Board has essentially converted the prior rejection of claim 1 under 35 U.S.C. § 103 based upon Lortz and Hopmann into a rejection of claim 1 under 35 U.S.C. § 102 based upon Lortz alone.

The Honorable Board's new findings and new analysis in the paragraph spanning pages 10 and 11 of the Decision constitute new grounds of rejection. Although a new rejection is commonly thought as being a "new grounds of rejection," a new rejection is not the only situation in which a designation of new grounds of rejection is appropriate.

Within In re Kumar,¹ an example of a "new grounds of rejection" was identified by the Federal Circuit. The patent application at issue within In re Kumar is U.S. Application No. 09/136,483. On February 29, 2000, a Final Office Action was issued in which claims 1-3, 5-16,

¹ 418 F.3d 1361, 1365. (Fed. Cir. 2005).

and 19-22 were rejected under 35 U.S.C. § 103 based upon Rostoker et al., U.S. Patent No. 5,389,194 alone or in view of Ueda et al., U.S. Patent No. 5,697,992.

On February 27, 2003, the Board of Patent Appeals & Interferences (hereinafter the BPAI) affirmed the Examiner's rejection based upon findings of fact (i.e., calculations) that were not presented by the Examiner. With regard to these new findings of fact, the Federal Circuit determined:

These calculations had not been made by the examiner, and according to the record were not presented during the argument of the appeal to the Board. The Board apparently made these calculations during its decision of the appeal. The Board included these calculations in an Appendix to its decision, holding that they support a *prima facie* case of obviousness and that Kumar's evidence had not rebutted the *prima facie* case.

In addressing rebuttal evidence that was presented (and refused consideration) in response to the BPAI's findings, the Federal Circuit further stated:

The values identified by the Board's calculations were not contained in the prior art or any examination record, but appeared for the first time in the Board's opinion. Although the PTO argues that the calculations the Board included in its decision were not new evidence, but simply an additional explanation of the Board's decision, these values produced and relied on by the Board had not previously been identified by the examiner or the Board. Kumar was entitled to respond to these calculations, and the Board committed procedural error in refusing to consider the evidence proffered in response.

The Federal Circuit concluded that "the Board's calculations and its decision based thereon constituted a new ground of rejection." Thus, the introduction of new findings, even though these findings related to a previously-presented rejection, constituted a new grounds of rejection.

Referring In re DeBlauwe, 736 F.2d 699, 706 n.9 (Fed. Cir. 1984), the Federal Circuit further stated "[w]here the board makes a decision advancing a position or rationale new to the

proceedings, an applicant must be afforded an opportunity to respond to that position or rationale by submission of contradicting evidence").

In response to the BPAI denying a request that the BPAI designate a rejection as "new" and allow new evidence to be introduced, within In re Ansel, 852, F.2d 1294 (Fed. Cir. 1988) (designated as an Unpublished Disposition), the Federal Circuit stated:

We cannot agree with the board that its reasoning does not represent a significant shift in the basic thrust of the rejection. Not only do the rejections at issue here represent different views of what the cited references teach, they also require the applicants to respond in quite different manners.

...
See In re Echerd, 471 F.2d 632, 635, 176 USPQ 321, 323 (CCPA 1973) (board's new reliance on only one of two references and on new portions of that reference to support an alternative theory constitutes a new rejection and possibly even shifts the statutory basis for the rejection). (emphasis added)

Based upon the above-discussed decisions, Appellants' position is that the Honorable Board's new findings of fact as well as the Honorable Board's new analysis constitute new grounds of rejection. Since it is impossible for Appellants to have responded to these new findings of fact and new analysis, Appellants were not afforded a fair opportunity to react to the new thrust of the rejection. Moreover, consistent with the case law discussed above, the Honorable Board's new reliance on only Lortz of the two cited references and on new portions of Lortz constitutes a new rejection. Therefore, should the Honorable Board maintain the present rejection of the claims based upon Lortz, Appellants respectfully request that the Honorable Board enter a new ground of rejection pursuant to 37 C.F.R. § 41.50(b).

Lortz fails to teach "state data for said resource"

Reference is made to the paragraph spanning pages 10 and 11 of the Decision in which the Honorable Board wrote:

We find that Lortz discloses a policy structure with two portions: a device policy and a user policy (FF#2). We read Lortz's device policy as being similar to Appellants' claimed "state data." We note that Appellants chose not to specifically limit the meaning of "state data." (Spec. ¶ [0026]). Rather, Appellants merely provided examples of state data (*id.*). Reading the claim language broadly but reasonably, *see Zletz*, cited above, we find that Appellants' claimed "state data" reads on Lortz's "device policy." We find that Lortz must retrieve a first portion (Appellants' claimed "state data") of the policy structure and a second portion (Appellants' claimed "retrieved policy") to gain access to a resource (Appellants' claimed "resource"). Lortz's disclosure is no different from Appellants' claim limitations "retrieving state data for said resource and applying said retrieved policy to said retrieved state data" and "permitting said administrative task only if said retrieved state data satisfies said set of rules in said retrieved policy." Accordingly, we find no error in the Examiner's conclusion of obviousness. (emphasis added)

Although Appellants will attempt to respond to this analysis and findings, Appellants cannot introduce extrinsic evidence to support Appellants' assertions. As previously noted, the above-reproduced paragraph represents an entirely new analysis based upon new findings of facts to which Appellants have not been afforded a fair opportunity to respond.

Turning to the Honorable Board's newly-presented analysis, the Honorable Board stated "we find that Appellants' claimed 'state data' reads on Lortz's 'device policy.'" The Honorable Board also identifies a second portion (i.e., a user policy) and with regard to the second portion

1 that Honorable asserts that the second portion corresponds to "Appellants' claimed 'retrieved
2 policy." Since the Honorable Board "concentrate[d] on Lortz for all of the limitations of claim
3 1," the Honorable Board's findings as to these limitations have to be consistent with the other
4 limitations recited in claim 1.

5
6 Specifically, claim 1 recites "permitting said administrative task only if said further
7 retrieved state data satisfies said set of rules in said retrieved policy." This limitation is further
8 discussed in paragraph [0025] of Appellants' disclosure, which states "[i]n block 335, the rules
9 can be applied to the list of state data and information to determine whether the action is
10 permissible in view of the current state of the network." To rephrase the above-identified
11 limitations using the alleged teachings of Lortz yields the following: "permitting said [accessing
12 a resource] only if said further retrieved [device policy] satisfies said set of rules in said [user
13 policy]." Lortz, however, fails to teach these limitations, as arranged in claim 1.

14
15 The device policy of Lortz is in no way used to satisfy a set of rules in the user policy.
16 As would be recognized by those skilled in the art, a policy is simply a set of rules used for
17 governance/management. Based upon some input, the policy determines a specific action to
18 take. However, the input for the user policy is not the device policy. Thus, the device policy of
19 Lortz cannot satisfy a set of rules in the user policy. Although Lortz teaches that the device
20 policy and the user policy can be combined, this is no manner comparable to using the device
21 policy to satisfy a set of rules in a user policy.

1 Additionally, based upon the plain language of the claims a resource policy is not
2 comparable to state data for a resource. Although a resource policy may govern the usage of a
3 resource, state data for a resource describes a state of the resource. As claimed, the retrieved
4 policy uses the state data for the resource to govern the resource (i.e., to permit the
5 administrative task directed to the resource). However, Lortz does not teach that the resource
6 policy uses state data for the resource. Instead, Lortz describes the access to the resource (which
7 is not the same an administrative task directed to the resource) is governed by a permission level
8 attribute 44, which does not reflect a state of the resource. Instead, as discussed in paragraph
9 [0021] of Lortz, the permission level attribute reflects a level of permission of a user of the
10 resource.

11
12 Since the Honorable Board's new analysis relies upon the finding that "Appellants'
13 claimed 'state data' reads on Lortz's 'device policy,'" and this finding is not supported by
14 substantial evidence, the Honorable Board has committed reversible error in asserting that Lortz
15 teaches the limitations at issue.

16
17 For the reasons set forth in the Appeal Brief of February 22, 2008, and in the Reply Brief
18 of June 17, 2008, and for those set forth herein, Appellants respectfully solicit the Honorable
19 Board to reverse the Examiner's rejections under 35 U.S.C. § 103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: August 9, 2010

Respectfully submitted,

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CUSTOMER NUMBER 46320